## REMARKS

Claims 1 and 3-9 are all the claims pending in the application.

Preliminarily, Applicants respectfully request a personal interview between the Examiner and the undersigned at a mutually convenient time. In this regard, a Request for Examiner Interview is being filed concurrently herewith.

### I. Claim Rejections - 35 U.S.C. § 112, ¶1

On page 3 of the Office Action of May 27, 2009, claims 7 and 9 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

A. Regarding claim 7, Applicants submit that in the Amendment Under 37 C.F.R. § 1.116 filed August 27, 2009, claim 7 was amended to recite the weight average molecular weight of the difunctional urethane (meth) acrylate as 8,000 to 14,000, and arguments were presented in the Remarks section as to why present claims 7 complies with the written description requirements.

In the Advisory Action dated September 8, 2009, it was argued that claim 7 would still be rejected under 35 U.S.C. § 112, first paragraph for reasons of record.

Applicants respectfully traverse for the following reasons.

Applicants respectfully draw attention to the decision in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), cited at MPEP § 2163.05(III).

In *Wertheim*, the original specification disclosed a range of 25-60% and also disclosed specific examples of 36% and 50%. *Id.*, at 262, *Id.*, at 96. The court held that the limitation "between 35% and 60%" was adequately supported by the original specification, stating that "as

a factual matter, persons skilled in the art would consider processes employing a 35-60% solids content range to be part of [Applicants'] invention." *Id.*, at 265, *Id.*, at 98. The court noted that the USPTO did not present sufficient reasons to doubt that the broader described range also described the somewhat narrower claimed range; that is, it did not contend that there was in fact any distinction between the claimed range and the range originally disclosed. *Id. at 264, Id.* Instead, the court indicated that the USPTO had "done nothing more than to argue lack of literal support, which is not enough." *Id.*, at 265, *Id.* (Emphasis added). The USPTO's insistence that the invention claimed be described in *ipsis verbis* (i.e., "in the same words") in order to satisfy the written description requirement was misplaced and inadequate. *Id., Id. See* also, MPEP § 2163.II.A.3(a).

In the present application, Applicants submit that the position that the Office has taken in the Office Action of May 27, 2009, and in the Advisory Action of September 8, 2009, is the same as that of the USPTO's in *Wertheim.*

Turning to the present disclosure, the Office has the burden to give reasons why a description that is not in *ipsis verbis* is insufficient, according to the court in *Wertheim.* However, the Office has provided no evidence or argument that there is in fact any distinction, between the recited range (i.e., 8,000-14,000) and the range disclosed in the original specification (i.e., 3,000 to 20,000) (see the paragraph bridging pages 5 and 6). Thus, Applicants respectfully submit that the Office is improperly insisting that Applicants recite the weight average molecular weight *ipsis verbis* without providing any reasons.

Instead, it has already been admitted in the Office Action that there is support in the original specification for the weight average molecular weight of the difunctional (meth) acrylate of 3,000-20,000 or 5,000-15,000. *See*, page 3, paragraph 7 of the final Office Action dated May 27, 2009. As Applicants have already pointed to examples in the original specification of difunctional urethane (meth) acrylates having weight average molecular weights of 8,000 and 14,000, Applicants submit that a skilled artisan would consider a difunctional urethane (meth) acrylate having a weight average molecular weight of 8,000-14,000 to be part of Applicants' invention and that the original specification meets the written description requirement for the range in claim 7.

Accordingly, Applicants respectfully submit that present claim 7 complies with the written description requirements.

Withdrawal of the rejection is respectfully requested.

B. Regarding claim 9, Applicants thank the Examiner for indicating in the Advisory Action of September 8, 2009 that if the Amendment Under 37 C.F.R. § 1.116 was entered, the rejection of claim 9 under 35 U.S.C. § 112, first paragraph would be overcome. Since entry of the Amendment Under 37 C.F.R. § 1.116 is requested in the Request for Continued Examination concurrently filed herewith, withdrawal of the rejection of claim 9 is respectfully requested.

**II. Claim Rejections - 35 U.S.C. § 112, ¶2**

On page 4 of the Office Action, claims 1-4 and 6-9 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

A. Regarding claim 9, Applicants thank the Examiner for indicating in the Advisory Action of September 8, 2009 that if the Amendment Under 37 C.F.R. § 1.116 was entered, the rejection of claim 9 under 35 U.S.C. § 112, second paragraph would be overcome. Since entry of the Amendment Under 37 C.F.R. § 1.116 is requested in the Request for Continued Examination concurrently filed herewith, withdrawal of the rejection of claim 9 is respectfully requested.

B. Regarding the remaining claims, Applicants submit that in the Amendment Under 37 C.F.R. § 1.116, claim 2 has been canceled, rendering the rejection moot for this claim. Further, in the Amendment Under 37 C.F.R. § 1.116, claims 1 and 8 have been amended to recite specific polymerizable compounds, in order to more clearly recite what compounds are included as other polymerizable compounds.

Withdrawal of the rejection is respectfully requested.

**III. Claim Rejections - 35 U.S.C. § 103**

On page 5 of the Office Action, claims 1, 3, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barrera in view of Mori. On page 9 of the Office Action, claims 4 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barrera in view of Mori, and further in view of Onozawa et al. On page 10 of the Office Action, claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Barrera in view of Mori and further in view of Furuya et al.

In the Amendment Under 37 C.F.R. § 1.116, arguments were presented in the Remarks section as to why the present claims are patentable over Barrera in view of Mori.

Further, Applicants submit that Onozawa et al. do not make up for the deficiencies of Barrera and Mori as discussed in the Amendment Under 37 C.F.R. § 1.116, and therefore a *prima facie* case of obviousness has not been made because the cited documents do not teach each and every element of the present claims 4 and 9.

Further, Applicants submit that Furuya et al. do not make up for the deficiencies of Barrera and Mori as discussed in the Amendment Under 37 C.F.R. § 1.116, and therefore a *prima facie* case of obviousness has not been made because the cited documents do not teach each and every element of the present claim 6.

Withdrawal of the rejections is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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